

REMARKS

Claims in the case are 1, 3-5, 7, 9, 12, 17-24, 29 and 30. No claims have been amended, no claims have been added, and no claims have been cancelled herein.

The obviousness and anticipation rejections in the previous Office Action of March 10, 2003 are deemed to be withdrawn, as the present Office Action of July 9, 2003 makes no reference to them.

Claims 1, 3-5, 7, 9, 12, 17-24 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,131,575 (**Adelmann et al**) in view of United States Patent No. 5,710,204 (**Harke et al**). This rejection is respectfully traversed with regard to the following remarks.

Adelmann et al disclose thermoplastic molding materials of high molecular weight, thermoplastic, aromatic polycarbonates, and 0.01 to 0.1 wt.% of esters of C₁₀₋₂₀ saturated aliphatic carboxylic acids with 4- to 6-hydric alcohols (abstract). However, Adelmann et al does not disclose, teach or suggest the thermoplastic polymer mixtures of Applicants' present claims. In particular, Adelmann et al does not disclose, teach or suggest a thermoplastic polymer mixture that includes at least one polycarbonate selected from the group consisting of copolymers of bisphenol A with trimethylcyclohexyl bisphenol containing 5 to 50 wt. % of trimethylcyclohexyl bisphenol. Further, Adelmann et al does not disclose, teach or suggest a thermoplastic polymer mixture that includes the combination of: (a) at least one polycarbonate selected from the group consisting of copolymers of bisphenol A with trimethylcyclohexyl bisphenol containing 5 to 50 wt. % of trimethylcyclohexyl bisphenol; and (b) a mold release agent containing a polyol residue selected from formulas (i)-(v) which has the same number of esterified groups and free hydroxyl groups.

Adelmann et al discloses thermoplastic molding compositions.

Adelmann et al do not disclose or suggest castable or curable compositions.

Adelmann et al do not disclose, teach or suggest the presence of curable monomers, such as acrylic acid monomers and/or derivatives thereof, in their thermoplastic molding compositions.

Harke et al disclose a castable, curable composition that includes, (i) acrylic acid monomer and/or derivatives thereof, and (ii) a polycarbonate copolymer of bisphenol A and trimethylcyclohexyl bisphenol. See the abstract; column 1, line 44 through column 2, line 36; and column 3, lines 36-53 of Harke et al. The polycarbonate copolymer of bisphenol A and trimethylcyclohexyl bisphenol is included in the curable compositions of Harke et al for purposes of improving the boiling resistance of cured plastic articles prepared therefrom (abstract). Harke et al do not disclose or suggest thermoplastic molding compositions.

Adelmann et al disclose thermoplastic molding compositions. Adelmann et al do not disclose or suggest the presence of curable monomers, such as acrylic acid monomers and/or derivatives thereof, in their thermoplastic molding compositions. Harke et al disclose castable, curable compositions that include acrylic acid monomers and/or derivatives thereof. Harke et al do not disclose or suggest thermoplastic molding compositions. The thermoplastic compositions of Adelmann et al can not be used as curable or castable molding compositions, as they are not curable. The curable, castable compositions of Harke et al can not be used as thermoplastic molding compositions, as they are not moldable in the absence of curing of the monomer component.

As such, neither Adelmann et al nor Harke et al provide the requisite motivation that would lead one of ordinary skill in the art to combine or otherwise modify their disclosures.

As the Court of Appeals for the Federal Circuit has stated, there are three possible sources for motivation to combine references in a manner that would render claims obvious. These are (1) the nature of the problem to be solved, (2) the teaching of the prior art, and (3) the knowledge of persons of ordinary skill in the art, *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The nature of the problem to be solved and the knowledge of persons of ordinary skill in the art are not present here and have not been relied upon in the rejection. As for the teaching of the prior art, the above discussion has established that neither of the patents relied upon in the rejection provide the requisite teaching, and certainly do not provide the motivation or suggestion to combine that is required by Court decisions.

The present rejection appears to use Applicants' specification as a blueprint for selecting and combining or modifying the cited references to arrive at Applicants' claimed invention, thereby making use of prohibited hindsight in the selection and application of those cited references. "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed.Cir.1983).

It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 1075 (CAFC, 1988).

But for the application of prohibited hindsight reconstruction, the combination of Adelmann et al and Harke et al would result in a curable/castable composition that includes curable acrylic acid monomers and/or derivatives thereof. As discussed previously Applicants' claimed composition is a thermoplastic composition that is neither curable nor castable, and does not include curable monomers, such as acrylic acid monomers and/or derivatives thereof.

In light of the preceding remarks, Applicants' claims are deemed to be unobvious and patentable over Adelmann et al in view of Harke et al.

Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1, 3-5, 7, 9, 12, 17-24 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adelmann et al in view of Harke et al, and further in view of European Patent Application No. 0 511 640 (**Shimada**).

Adelmann et al and Harke et al have each been discussed previously herein. Shimada discloses a molding composition which includes a polycarbonate having a specific viscosity range, and 0.001 to 0.1 pphr of a saturated monovalent fatty acid monoglyceride (abstract). The molding compositions of Shimada are disclosed as

being useful in the fabrication of optical moldings, such as compact disks (page 2, lines 1-4). However, Shimada does not disclose, teach or suggest a thermoplastic polycarbonate composition which includes at least one polycarbonate selected from the group consisting of copolymers of bisphenol A with trimethylcyclohexyl bisphenol containing 5 to 50 wt. % of trimethylcyclohexyl bisphenol. In particular, Shimada do not disclose, teach or suggest a thermoplastic polymer mixture that includes the combination of: (a) such a polycarbonate; and (b) a mold release agent containing a polyol residue selected from formulas (i)-(v) which has the same number of esterified groups and free hydroxyl groups.

Adelmann et al disclose thermoplastic molding compositions. Adelmann et al do not disclose or suggest the presence of curable monomers, such as acrylic acid monomers and/or derivatives thereof, in their thermoplastic molding compositions. Harke et al disclose castable, curable compositions that include acrylic acid monomers and/or derivatives thereof. Harke et al do not disclose or suggest thermoplastic molding compositions. The thermoplastic compositions of Adelmann et al can not be used as curable or castable molding compositions, as they are not curable. The curable, castable compositions of Harke et al can not be used as thermoplastic molding compositions, as they are not moldable in the absence of curing of the monomer component. Shimada disclose thermoplastic molding compositions. Shimada do not disclose or suggest the presence of curable monomers, such as acrylic acid monomers and/or derivatives thereof, in their thermoplastic molding compositions. The thermoplastic compositions of Shimada can not be used as curable or castable molding compositions, as they are not curable.

As such, neither Adelmann et al, Harke et al nor Shimada provide the requisite motivation that would lead one of ordinary skill in the art to combine or otherwise modify their disclosures. The three possible sources of motivation for combining references, as described by the Court of Appeals for the Federal Circuit and discussed previously herein, are not present. *In re Rouffet*, 47 U.S.P.Q.2d at 1458. The nature of the problem to be solved and the knowledge of persons of ordinary skill in the art are not present here and have not been relied upon in the

rejection. As for the teaching of the prior art, the above discussion has established that none of the patents relied upon in the rejection provide the requisite teaching, and certainly do not provide the motivation or suggestion to combine that is required by Court decisions.

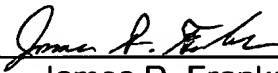
The present rejection appears to use Applicants' specification as a blueprint for selecting and combining or modifying the cited references to arrive at Applicants' claimed invention, thereby making use of prohibited hindsight in the selection and application of those cited references. As discussed previously herein, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d at 1075. See also the discussion previously herein with regard to *W.L. Gore & Assoc.*, 721 F.2d at 1553.

But for the application of prohibited hindsight reconstruction, the combination of Adelmann et al, Harke et al and Shimada would result in a curable/castable composition that includes curable acrylic acid monomers and/or derivatives thereof. As discussed previously Applicants' claimed composition is a thermoplastic composition that is neither curable nor castable, and does not include curable monomers, such as acrylic acid monomers and/or derivatives thereof.

In light of the preceding remarks, Applicants' claims are deemed to be unobvious and patentable over Adelmann et al in view of Harke et al, and further in view of Shimada. Reconsideration and withdrawal of this rejection is respectfully requested.

In light of the amendments herein and the preceding remarks, Applicants' presently pending claims are deemed to define an invention that is unanticipated, unobvious and hence, patentable. Reconsideration of the rejections and allowance of all of the presently pending claims is respectfully requested.

Respectfully submitted,

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